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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
902,944	10/31/00	FUKUDA	H 20498

000151
HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
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HM12/1025

EXAMINER
MORRIS, P

ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 10/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

89/702,944

Applicant(s)

Fukuda et al

Examiner

P. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-31 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-27, 30 and 31, drawn to compounds of formula (I), compositions and use classified in classes 540, 544, 25 and 548, various subclasses.
- II. Claim 28, drawn to intermediates, classified in classes 540, 544, 546 and 548, various subclasses.
- III. Claim 29, drawn to intermediates, classified in classes 540, 544, 546 and 548, various subclasses.

The inventions are distinct, each from the other because of the following reasons:

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes as indicated is considered proper; 35 U.S.C. 121; 37 CFR 1.141; 37 CFR 1.142.

Inventions I and II, III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as corrosion inhibitors, photographic antifogging agents, sedatives,

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etc., and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

In the event of an election of either Groups I, II or III, applicants are required to elect a single disclosed species representative of the claimed invention since the variations in Q, R¹ and R³ etc. encompass all heterocyclic rings classified in classes 540, 544, 546 and 548, various subclasses. Each heterocycle represents an independent and patentably distinct invention. The staggering arrangement of possibilities does not permit classification of the claimed subject matter.

Should applicant(s) traverse on the ground that the species inventions identified are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the above identified species inventions to be obvious variants, or clearly admit on the record that this is the case. In either instance, of traverse, if the examiner finds one of the

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inventions in the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

“A Markush-type claim is directed to “independent and distinct inventions”, if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s)”. In re Weber, 198 USPQ 330, footnote 3.

CFR 1.141 (a) provides that two or more independent and distinct inventions may not be claimed in one application. In one application means in one application, whether or not the misjoinder occurred in one claim or more than one claim. This is consistent with new PCT Rule 13.3.

“13.3 Determination of Unity of Invention Not Affected by Manner of Claiming.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim”.

Where restriction is going to be exercised is where independent and distinct inventions are presented in one Markush grouping.

A reference to a pyridine here would not be a reference to a thiazole. When one writes out the entire compound, as a whole, one arrives at patentably distinct heterocyclic compounds, along the lines indicated in the Groups of the first page of this action. Distinct, independent, heterocyclic nuclei.

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If the members are so diverse that they will support separate patents, *i.e.*, a reference for one would not constitute a reference for the other, then restriction is considered proper. MPEP 2173.05(h).

It is too burdensome for the examiner to search all of the previously noted searches in their respective, completely divergent, areas for the non-elected subject matter, as well, in the limited time provided to search one invention.

In, In re Weber, 198 USPQ 332, In re Hengehold, 169 USPQ 473, was noted for the proposition that as long as applicants have maintained the right (as they do here) to file the non-elected subject matter in divisional applications, then restriction is proper, as to that point.

Applicant may file the divisional subject matter noted in divisional applications. If applicant wishes a generic expression of the elected invention the claims here need be amended to reflect that election.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

This restriction requirement is being written as previous experience has indicated that with Foreign applicants and the inherent time delays, applicants' representative is better able to make an informed, correct, election of the invention applicants would wish to have prosecuted here if applicants are given the opportunity to see the restriction requirement laid out, and given the time to make an informed decision.

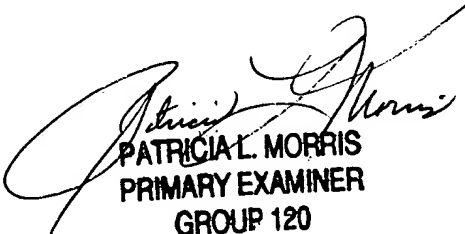
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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

plm

October 24, 2001



PATRICIA L. MORRIS
PRIMARY EXAMINER
GROUP 120